

REMARKS

Claims 1-12 stand rejected. Claim 6 was objected to. Claims 1, 6 and 7 have been amended. Claim 11 has been canceled without prejudice. New Claims 13, 14 and 15 have been introduced, without addition of new matter. Claims 1-10 and 12-15 are therefore pending in this application. In view of the foregoing amendments and the following remarks, it is respectfully submitted that all of the presently pending claims are allowable, and reconsideration is respectfully requested.

1. Objection to Claim 6

The Examiner objected to claim 6 for informalities. Applicants submit that the informalities were due to typographical error. In Claim 6, the term “symbols” has been corrected to “the symbols” as suggested by the Examiner. No new matter has been added, and no change in claim scope or surrender of claimed subject matter is intended. Applicants respectfully request withdrawal of the objection.

2. Rejection of Claims 1-12 (35 U.S.C. § 112)

Claims 1-12 were rejected under 35 USC § 112, second paragraph, as indefinite. The Examiner’s comments are addressed as follows:

- a. The expression “one of” in Claims 1, 3 and 7 denotes an alternative between two items. Applicants submit that the expression is well-known, widely used, and unambiguous. Applicants submit that the claims are definite and therefore allowable.
- b. The expression “at the same location” used in Claim 7 is defined in the specification. However, to expedite prosecution of the claimed subject matter, Claim 7 has been amended to include an additional phrase to that extent. No new matter has been added, and no change in claim scope or surrender of claimed subject matter is intended.
- c. Claim 1 having being shown to be allowable, Applicants submit that its pending dependent claims 2-6, 8-10 and 12 are likewise allowable.

Based on the foregoing arguments, Applicants respectfully request withdrawal of the rejection of pending Claims 1-10 and 12 under 35 USC § 112.

3. Rejection of Claims 1-4 and 6-12 (35 U.S.C. § 103(a))

Claims 1-4 and 6-12 were rejected under 35 U.S.C. § 103(a) as obvious over US Patent Application Publication No 2002/0130906 (Miyaki) in view of US Patent No 6,640,185 (Yokota et al). Applicants submit that the rejections should be withdrawn for at least the following reasons.

Miyaki generally describes a point-of-interest (POI) icon display method wherein a representative icon (multi-icon icon) may replace a large number of POI icons. Yokota et al. generally describe a display apparatus for navigation system including name list screens.

In order for a claim to be rejected under 35 U.S.C. § 103(a), not only must the cited references teach or suggest each element of the claim, but the prior art must also *suggest* combining the elements in the manner contemplated by the claim. M.P.E.P. § 2143.01. A prior art reference must be considered in its entirety, i.e., as a whole, including portions that would lead away from the claimed invention. M.P.E.P. § 2141.02. Applicants submit that the combined references would not teach each element of the claims.

Claim 1 has been amended to recite the limitations of now-canceled claim 11, i.e., “a color chosen for the indicator symbol depends on at least one of a type and a number of special objects.” Applicants note that Miyaki and Yokota et al. fail to teach or suggest this limitation. Referring by way of example to the embodiment of the invention as described in the present application, the association of a specific color to objects of different relevance to the user (a hospital may be more important than a hotel, which in turn may be more important than a restaurant) is not taught nor suggested by Miyaki or Yokota et al.

In this respect, it is stated in the Office Action that “assigning color according to a type and number of display symbols would have been an obvious design choice based on a specific designer preference.” Applicants respectfully traverse the Official Notice. To use an example from everyday life, the use of three different colors in a traffic light is not certainly a matter of design or decoration, but serves to inform drivers of how to safely approach an intersection. Another example of using color to convey information is the familiar multi-color LED battery life indicator on consumer electronics products (green for fully charged, red for low battery). Such use of color is not taught or suggested by Miyaki or Yokota et al., nor would it be obvious to a person with ordinary skills in the art.

Applicants further submit that there is no motivation to actually combine Miyaki and Yokota et al.; instead, the applied references actually teach away from the asserted combination and from the presently claimed invention, as detailed below.

Miyaki does not suggest the display of a selection menu containing information about the POIs. On the contrary, Miyaki suggests that upon selection of a multi-icon icon, the screen should simply display the original individual POIs, possibly slightly displaced from each other to avoid crowding of the picture (Fig. 9A; para. 0045). Since the multi-icon icon of Miyaki reverts to the original multiple icons upon being selected, no user-interaction events of higher complexity are suggested. Note that Miyaki suggests a radically different solution to the problem addressed in the present application, therefore *teaching away* from the presently claimed subject matter.

On the other hand, Yokota et al. disclose a name list screen displaying a list of names of the POIs specified by a cursor marker (column 14, lines 14-16). Yokota et al. also recognize the problem of overcrowded or overlapping POIs, but propose a different solution than is claimed in the present application or in the Miyaki reference. Yokota et al. suggest as a simple (but less effective) solution to suppress the display of the icons when the map scale is too small (col.14, lines 49-59). By suggesting a radically different solution to the problem, Yokota et al. also *teach away* from the presently claimed subject matter and the teachings of the Miyaki reference.

For at least the foregoing reasons, Applicants respectfully traverse the proposed combination of Yokota et al. with Miyaki, which combination is based on an improper hindsight reconstruction, rather than based on a suggestion from the prior art that is “clear and particular.” *In re Dembiczak*, 50 U.S.P.Q.2d 1614 (Fed. Cir. 1999). Therefore, Applicants submit that Claim 1 is allowable.

Claims 2-4 and 6-10 and 11 being dependent from Claim 1, Applicants submit that these Claims are similarly allowable.

Independent of the above, Claim 7 recites an indicator symbol “one of (a) with a link to the selection menu and (b) embedded in the selection menu.” As discussed above, Yokota et al. disclose a name list screen occupying the entire display. Depressing the ‘Enter’ key switches the display to the name list screen. The icons and the name list screen are not

visually related but are displayed in alternative to each other. Even if the teachings of Yokota et al. are combined with those of Miyaki, the limitations of Claim 7 are still not taught or suggested, nor would the limitations be obvious to a person of ordinary skills in the art.

4. Rejection of Claim 5 (35 U.S.C. § 103(a))

Claim 5 was rejected under 35 U.S.C. § 103(a) as obvious over US Patent Application Publication No 2002/0130906 (Miyaki) in view of US Patent No 6,640,185 (Yokota et al) and further in view of US Patent Application Publication No 2002/0119995 (Sasaki) and US Patent No 5,283,560 (Bartlett). Sasaki generally describes superimposing a menu on a map, while Bartlett describes semi-transparent windows.

First of all, since it was previously shown that Claim 4 is allowable and since claim 5 depends on claim 4, Applicants submit that Claim 5 is similarly allowable.

Moreover, in order for a claim to be rejected under 35 U.S.C. § 103(a), not only must the cited references teach or suggest each element of the claim, but the prior art must also *suggest* combining the elements in the manner contemplated by the claim. M.P.E.P. § 2143.01. Miyaki does not mention selection menus or their relationship to maps. Yokota et al. do not discuss the advantages and limitations of name list screens, nor do they suggest that other means for representing information, such as menus superimposed on maps, would be desirable. Sasaki does not compare a menu superimposed on a map with a name list screen or point out the advantages of the superimposed menu (in fact, Sasaki focuses on the technical aspects of the video processing rather than on the user-interface aspects). Finally, Bartlett discusses semi-transparent windows without reference to the visualization of information on a map. In view of these unrelated teachings of the applied references, there is no suggestion in the applied art to modify the references in the manner suggested by the Examiner.

Furthermore, a prior art reference must be considered in its entirety, i.e., as a whole, including portions that would lead away from the claimed invention. M.P.E.P. § 2141.02. In this respect, the disclosure of Yokota et al. specifically refers to screen switching rather than superimposed menus. Referring to Fig.19 of Yokota et al., an elaborate algorithm is shown to switch between the display of a locator map and the display of name list screens. Fig. 10A

and 10B show how a user can switch between different displays by use of the Enter and Cancel keys. These descriptions of Yokota et al. clearly *teach away* from the use of superimposed menus as taught by Sasaki. Applicants therefore respectfully traverse the asserted combination of references, which combination is clearly based on a hindsight reconstruction.

For at least the foregoing reasons, Applicants respectfully request that the rejection of Claim 5 be withdrawn.

5. New Claims

To claim further aspects of the present invention, new Claims 13-15 have been added. Since all new claims are supported throughout the specification, no new matter has been added. Claims 13 and 14 ultimately depend on allowable claim 1. New claim 15 recites that “during the display of the selection menu, the indicator symbol is displayable at a same location on the map where it was displayed before the display of the selection menu, embedded in the selection menu.”

In contrast to claim 15, which recites displaying of the indicator symbol unchanged and to embed it into the selection menu, the applied prior art references do not show such an embedding. For example, in Miyaki, either the indicator symbol is displayed or the indicator symbol is dissolved into individual icons. This can be seen from the change of the representation from Figure 8 to Figure 9a in Miyaki. Furthermore, according to another specific embodiment of Figure 9b in Miyaki, additional information may be displayed as well. For this purpose, however, neither is a connection created to the original indicator symbol M, nor is indicator symbol M embedded in the selection menu. Similarly, Yokota also does not show such a representation. According to Figure 11 or 15b of Yokota, for example, an indicator symbol 107, 137 “POI Icon list” is represented, one being able to change to a list view following an appropriate input. In this selection, however, the map is no longer displayed. Likewise, the indicator symbol itself is no longer displayed, as well. For at least

Appl. No. 10/600,894
Attorney Docket No. 10191/3186
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these reasons, the overall combination of Miyaki and Yokota would not enable one skilled in the art to arrive at the subject matter of claim 15.

For the foregoing reasons, Applicants submit that new claims 13-15 are allowable.

CONCLUSION

In view of the above amendments and remarks, it is respectfully submitted that all of the presently pending claims are allowable. All issues raised by the Examiner having been addressed, an early and favorable action on the merits is earnestly solicited.

A two-month extension of time for responding to the Office Action of July 8, 2004 is requested. The extended period expires on December 8, 2004. The Office is authorized to charge \$430 extension fee and any other required fees associated with this Amendment to Kenyon & Kenyon Deposit Account No. 11-0600.

Respectfully Submitted,
KENYON & KENYON

Dated: 11/11/04

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